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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,482	04/22/2005	Christiane Kirchhoff	SCH-1887	6197

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EXAMINER	
ULM, JOHN D	
ART UNIT	PAPER NUMBER
1649	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,482	KIRCHHOFF ET AL.	
	Examiner	Art Unit	
	John D. Ulm	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-58 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 to 58 are pending in the instant application. Applicant is advised that a plurality of the claims that are pending in the instant application are improperly dependent claims. A properly dependent claim can not conceivably be infringed without infringing any of the claims from which it depends. Claims 19 and 34, for example, can not properly depend from claim 1 because an isolated polynucleotide that infringes claim 19 or an antibody that infringes claims 34 would not infringe the isolated protein of claim 1. See M.P.E.P. 608.01(n)III.

Claim 33 has not been included in any of the recited inventions because it is drawn to a method that employs "a cell of claim 35". Claim 35 is drawn to "an antibody".

Further, whereas claims 56 and 57 have been considered for restriction purposes, these claims make no sense.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:1, a polypeptide encoded thereby, and methods of use.

Group II, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:2 a polypeptide encoded thereby, and methods of use.

Group III, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:3 a polypeptide encoded thereby, and methods of use.

Group IV, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:4, a polypeptide encoded thereby, and methods of use.

Group V, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:5, a polypeptide encoded thereby, and methods of use.

Group VI, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:6, a polypeptide encoded thereby, and methods of use.

Group VII, claims 1 to 7, 19, 20, 23, 25, 28, 29, 30, 39 to 48, 50 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:7, a polypeptide encoded thereby, and methods of use.

Group VIII, claims 8 to 13, 21, 26, 25, 31, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:9, a polypeptide encoded thereby, and methods of use.

Group IX, claims 8 to 13, 21, 26, 25, 31, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:10, a polypeptide encoded thereby, and methods of use.

Group X, claims 8 to 13, 21, 26, 25, 31, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:11, a polypeptide encoded thereby, and methods of use.

Group XI, claims 8 to 13, 21, 26, 25, 31, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:12, a polypeptide encoded thereby, and methods of use.

Group X, claims 14 to 18, 22, 27, 32, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:13, a polypeptide encoded thereby, and methods of use.

Group XI, claims 14 to 18, 22, 27, 32, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:14 a polypeptide encoded thereby, and methods of use.

Group XII, claims 14 to 18, 22, 27, 32, 40 and 58, only in so far as they relate to an isolated polynucleotide comprising SEQ ID NO:15, a polypeptide encoded thereby, and methods of use.

Group XIII, claim 24, drawn to an isolated polynucleotide comprising nucleotides 1 to 91 of SEQ ID NO:16.

Groups XIV to XX, claims 34, 35 and 38, only in so far as they relate to an **antibody** that binds to an epitope encoded buy one of the seven different nucleotide

sequences recited therein. For example, Group XIV only relates to SEQ ID NO:1 whereas Group XXI only relates to SEQ ID NO:7.

Groups XXI to XXIX, claims 36, 51 and 52, only in so far as they relate to an **antagonist** to a polypeptide comprising an amino acid sequence encoded by one of the eight different nucleotide sequences presented in SEQ ID NO: 1 to 8. Applicant is advised that a larger nucleotide sequence that contains a smaller nucleotide sequence constitutes a further limitation of that smaller sequence. It is being assumed, based upon the construction of claim 5, that each of SEQ ID NO:1 to 7 is contained within at least one of SEQ ID NO:16 to 22.

Groups XXX to XXXVII, claims 37 and 49, only in so far as they relate to an **antisense polynucleotide** complementary to one of the eight different nucleotide sequences presented in SEQ ID NO: 1 to 8, and a method of use.

Group XXXVIII, claim 50, in so far as it relates to a diagnostic method that **measures the amount of antibodies** that bind to a polypeptide encoded by SEQ ID NO:8 in a sample.

Groups XXXIX to XLVI, claim 51, only in so far as it relates to a method of treating by administering an **agonist** to a polypeptide comprising an amino acid sequence encoded by one of the eight different nucleotide sequences presented in SEQ ID NO: 1 to 8.

Group XLVII, claims 53, 56 and 57, drawn to a polynucleotide comprising SEQ ID NO:33 and a method of using or composition comprising (?) a polypeptide encoded thereby.

The inventions listed as Groups I to XLVII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Inventions I to XLVII relate to forty seven different chemical compounds that do not reflect a common inventive concept because they lack a common structural feature or combination of features that distinguishes them as a group from related compounds of the prior art. The fact that the seven different sequences recited in claim 1, for example, can be combined into a single sequence does not provide them with a unifying inventive concept because any two or more nucleotide or amino acid sequences can be combined to form a larger sequence. Further, as indicated in the first sentence of the instant specification, human HE6, upon which the instant invention is based, was described in a reference that was published more than four years before the earliest effective filing date of the instant application.

Applicant is advised that, upon choosing a particular sequence for examination, that they should specifically identify any larger sequences described in the specification that contain the selected sequence.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (571) 272-0880. The examiner can normally be reached on 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JOHN ULM
PRIMARY EXAMINER
GROUP 1800